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In re Application of	:	DECISION ON
Susumu Yoshida et al	:	
PCT No.: PCT/JP2003/16953	:	
Application No.: 10/540,041	:	SECOND RENEWED
Int. Filing Date: 26 December 2003	:	
Priority Date: 27 December 2002	:	
Attorney's Docket No.: IWI-16045	:	PAPERS FILED
For: OIL-IN WATER TYPE EMULSION	:	
COSMETIC COMPOSITION	:	UNDER 37 CFR 1.42

This is a decision on the "RESPONSE TO DECISION ON RENEWED PAPERS FILED UNDER 35 C.F.R. 1.42" filed 14 May 2007.

**BACKGROUND**

In a decision from this Office on 13 March 2007, the request was dismissed. The decision indicated, inter alia, that the residence and mailing address of the legal representative (sole heir) and the deceased inventor had not been provided as required under 37 CFR 1.63.

On 14 May 2007, applicants filed the current response, stating that the enclosed executed declaration states that Ms. Keiko Nakamura is the sole heir.

**DISCUSSION**

A review of the application file still reveals that the declaration does not comply with 37 C.F.R. §1.497(b)(2).

Because the co-joint inventor Tadashi Nakamura is deceased Keiko Nakamura is the sole heir (legal representatives) for the deceased inventor, 37 C.F.R. §1.497(b)(2) indicates that "[i]f the person making the oath or the declaration or any supplemental or oath or declaration is not the inventor (§§1.42, 1.43, or 1.47), the oath or declaration **shall state the relationship of the person to the inventor**, and, upon information and belief, the facts which the inventor would have been required to state (the inventor's citizenship and so on). If the person signing the oath or declaration is the legal representative (sole heir) of a deceased inventor, the oath or declaration shall also state that the person is a legal representative and the citizenship, residence and mailing address of the legal representative." (see MPEP § 409.01)

In this instance, the declaration does not state that Ms. Keiko Nakamura is the sole heir of deceased inventor, Tadashi Nakamura because it only states "Sole Heir." Also, the declaration incorrectly puts Keiko Nakamura under the heading "Name of Additional Joint Inventor, if any," which erroneously implies that she is a joint inventor.

Consequently, applicants have not satisfied the requirements under 37 CFR 1.42.

### **CONCLUSION**

For the above reasons, the request for status under 37 CFR 1.42 is **not accepted**.

Applicant is required to provide an oath or declaration in compliance with 37 CFR 1.497(a)-(b) within TWO (2) MONTHS from the mail date of this Decision. Any reconsideration request should include a cover letter entitled "Second Renewed Submission Under 37 CFR 1.42." Extensions of time are available under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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Enclosed: Declaration Supplemental Sheet For Legal Representative (Sole heir), Form PTO/SB/02LR, to be filled in conjunction with an executed declaration.

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it contains a valid OMB control number.

# DECLARATION Supplemental Sheet

## For Legal Representatives (35 U.S.C. 117) On Behalf of A Deceased or Incapacitated Inventor

Enter Deceased or Incapacitated Inventor's Name \_\_\_\_\_

Page \_\_\_\_\_ of \_\_\_\_\_

<b>Name of Legal Representative:</b>		<input type="checkbox"/> A petition has been filed for this non-signing legal representative	
Given Name (first and middle (if any))		Family Name or Surname	
Legal Representative's Signature		Date	
Residence: City	State	Country	Citizenship
Mailing Address			
Mailing Address			
City	State	Zip	Country
<b>Name of Additional Legal Representative, if any:</b>		<input type="checkbox"/> A petition has been filed for this non-signing legal representative	
Given Name (first and middle (if any))		Family Name or Surname	
Legal Representative's Signature			
Residence: City	State	Country	Citizenship
Mailing Address			
Mailing Address			
City	State	Zip	Country
<b>Name of Additional Legal Representative, if any:</b>		<input type="checkbox"/> A petition has been filed for this non-signing legal representative	
Given Name (first and middle (if any))		Family Name or Surname	
Legal Representative's Signature		Date	
Residence: City	State	Country	Citizenship
Mailing Address			
Mailing Address			
City	State	Zip	Country

This collection of information is required by 35 U.S.C. 117 and 37 CFR 1.42, 1.43, 1.63 and 1.64(b). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 21 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 (1-800-786-9199) and select option 2.

## Privacy Act Statement

The **Privacy Act of 1974 (P.L. 93-579)** requires that you be given certain information in connection with your submission of the attached form related to a patent application or patent. Accordingly, pursuant to the requirements of the Act, please be advised that: (1) the general authority for the collection of this information is 35 U.S.C. 2(b)(2); (2) furnishing of the information solicited is voluntary; and (3) the principal purpose for which the information is used by the U.S. Patent and Trademark Office is to process and/or examine your submission related to a patent application or patent. If you do not furnish the requested information, the U.S. Patent and Trademark Office may not be able to process and/or examine your submission, which may result in termination of proceedings or abandonment of the application or expiration of the patent.

The information provided by you in this form will be subject to the following routine uses:

1. The information on this form will be treated confidentially to the extent allowed under the Freedom of Information Act (5 U.S.C. 552) and the Privacy Act (5 U.S.C. 552a). Records from this system of records may be disclosed to the Department of Justice to determine whether disclosure of these records is required by the Freedom of Information Act.
2. A record from this system of records may be disclosed, as a routine use, in the course of presenting evidence to a court, magistrate, or administrative tribunal, including disclosures to opposing counsel in the course of settlement negotiations.
3. A record in this system of records may be disclosed, as a routine use, to a Member of Congress submitting a request involving an individual, to whom the record pertains, when the individual has requested assistance from the Member with respect to the subject matter of the record.
4. A record in this system of records may be disclosed, as a routine use, to a contractor of the Agency having need for the information in order to perform a contract. Recipients of information shall be required to comply with the requirements of the Privacy Act of 1974, as amended, pursuant to 5 U.S.C. 552a(m).
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6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).
7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (*i.e.*, GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.
8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspection or an issued patent.
9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.